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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91216035
Party	Plaintiff GoPro, Inc. Formerly Woodman Labs, Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Trademark Application Serial No. 85825238
Mark: GOPRO G (and design)

<hr/>)	
GoPro, Inc.)	
	Opposer,)	Opposition No. 91216035
vs.)	
Ross Walmsley,)	
	Applicant.)	
<hr/>)	

OPPOSER GOPRO INC.'S TRIAL BRIEF

TABLE OF CONTENTS

INTRODUCTION	1
FACTUAL BACKGROUND	2
A. Opposer’s Rights in the GOPRO Mark	2
B. Applicant’s Application to Register the Mark GOPRO G	4
SUMMARY OF THE RECORD AND ISSUES TO BE DECIDED	4
ARGUMENT	6
A. GoPro’s Registration No. 3032989 Establishes Its Priority and Standing.	6
B. Registration of Application No. 85825238 for the GOPRO G Mark Is Likely to Cause Consumer Confusion with Opposer’s GOPRO Marks.	6
1. The Marks Are Virtually Identical in Appearance, Sound, and Commercial Impression.	7
2. GoPro’s Mark Is Famous.	8
3. The Application Covers Goods that Are Related to Goods Offered by GoPro.	9
4. GoPro and Applicant’s Trade Channels.	10
5. Applicant’s Customer Are Impulse Buyers.	11
6. Applicant Selected His Confusingly Similar Mark with an Intent to Confuse.	11
C. Registration of Application No. 85825238 for the GOPRO G Mark Is Likely to Dilute Opposer’s Famous GOPRO Mark.	12
D. Registration of Application No. 85825238 for the GOPRO G Mark Will Create a False Suggestion of a Connection with GoPro.	12
CONCLUSION	13

TABLE OF AUTHORITIES

CASES

<i>7-Eleven, Inc. v. Lawrence Wechsler</i> , 83 USPQ 2d 1715 (TTAB 2007)	6, 12
<i>American Hygienic Labs Inc. v. Tiffany & Co.</i> , 12 USPQ 2d 1979 (TTAB 1989)	10
<i>Bose Corp. v. QSC Audio Products, Inc.</i> , 63 USPQ 2d 1303 (Fed. Cir. 2002).....	8, 9
<i>CBS Inc. v. Morrow</i> , 218 USPQ 198 (Fed. Cir. 1983).....	10
<i>Century 21 Real Estate Corp. v. Century Life of Am.</i> , 23 USPQ 2d 1698 (Fed. Cir. 1992).....	13
<i>China Healthways Inst., Inc. v. Wang</i> , 491 F.3d 1337 (Fed.Cir.2007)	7
<i>Edom Laboratories, Inc. v. Glenn Lichter</i> , 102 USPQ 2d 1546 (TTAB 2012)	11
<i>Han Beauty Inc. v. Alberto-Culver Co.</i> , 57 USPQ 2d 1557 (Fed. Cir. 2001).....	6
<i>Hewlett-Packard Co. v. Packard Press Inc.</i> , 62 USPQ 2d 1001 (Fed. Cir. 2002).....	10
<i>In re E. I. du Pont de Nemours & Co.</i> , 177 USPQ 563 (CCPA 1973)	6, 11
<i>In re Melville Corp.</i> , 18 USPQ 2d 1386 (TTAB 1991)	9
<i>In re Mighty Leaf Tea</i> , 601 F.3d 1342 (Fed. Cir. 2010)	7
<i>In re Mucky Duck Mustard Co.</i> , 6 USPQ 2d 1467, <i>aff'd per curiam</i> , 864 F.2d 149 (Fed. Cir. 1988)	10
<i>In re West Point–Pepperell, Inc.</i> , 468 F.2d 200 (CCPA 1972)	7

<i>J & J Snack Foods Corp. v. McDonald’s Corp.</i> , 18 USPQ 2d 1889 (Fed. Cir. 1991).....	9
<i>Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.</i> , 22 USPQ 2d 1453 (Fed.Cir.1992).....	8, 9
<i>Miller Brewing Co. v. Anheuser-Busch Inc.</i> , 27 USPQ 2d 1711 (TTAB 1993)	12
<i>Nina Ricci S.A.R.L. v. E.T.F. Enters. Inc.</i> , 12 USPQ 2d 1901 (Fed. Cir. 1989).....	9
<i>Palm Bay Imports, Inc.</i> , 73 USPQ 2d 1689	6, 11
<i>Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772</i> , 396 F.3d 1369 (Fed. Cir. 2005)	2
<i>Pom Wonderful LLC v. Hubbard</i> , 775 F.3d 1118 (9th Cir. 2014)	8
<i>Veuve Clicquot Ponsardin, Maison Fondée En 1772</i> , 2003 WL 2003 WL 21953664 (Aug. 4, 2003).....	2
STATUTES	
15 U.S.C. § 1063(a)	6
15 U.S.C. § 1125(c)	12
Lanham Act Section 2(a)	5, 6, 12, 13
Lanham Act Section 2(d)	5, 6, 11
Lanham Act Section 43(c)	5, 12
OTHER AUTHORITIES	
37 C.F.R. §2.122	4
Federal Rule of Civil Procedure 36(a)(3)	4
TBMP § 407.03(a)	4

GoPro Inc. (“GoPro”) requests a judgment denying registration by Ross Walmsley (“Applicant”) of the mark GOPRO G (and design) for the goods listed in Application Serial No. 85825238 because of a likelihood of confusion between the GOPRO and GOPRO G (and design) marks, and dilution and false suggestion of a connection by the GOPRO G (and design) mark.

INTRODUCTION

GoPro is a well-known company and award-winning producer of cameras, accessories, and technology that enables people to self-capture immersive and engaging footage of themselves enjoying their favorite activities. GoPro filed this opposition to prevent registration of the mark GOPRO G (and design) —an obvious play on GOPRO—for goods similar to those GoPro sells.

Applicant’s admissions in this matter establish that GoPro is entitled to judgment because confusion by consumers is likely. In particular, Applicant has admitted that:

- GOPRO is a famous mark.
- The GOPRO and GOPRO G (and design) marks are virtually identical.
- Applicant knew of GoPro and its GOPRO mark before using or applying for the GOPRO G (and design) mark.
- Applicant selected the GOPRO G (and design) mark because it is likely to be confused with GoPro’s GOPRO mark.
- The goods in the GOPRO G (and design) application are related to the goods marketed under the GOPRO mark.

- The goods in the GOPRO G (and design) application can be, and are intended to be, used in connection with GoPro's products.
- Applicant's use and continuing use of trade-channels that overlap with GoPro will create a likelihood of confusion regarding the origin and affiliation of his goods with GoPro's goods.

On the basis of similar established facts, the Board has found that confusion with famous marks is likely, and has refused registration. *See, e.g., Veuve Clicquot Ponsardin, Maison Fondee En 1772*, 2003 WL 21953664, at *1 (Aug. 4, 2003) *aff'd Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369 (Fed. Cir. 2005). A refusal of registration is equally warranted here.

FACTUAL BACKGROUND

A. Opposer's Rights in the GOPRO Mark

GoPro owns the following U.S. Trademark Registration for the GOPRO mark ("GOPRO"):

Trademark	Reg. No.	Full Goods Description	Filing Date	Registration Date
GOPRO	3,032,989	(Int'l Class: 9) Photographic equipment, namely film cameras and digital cameras, cases and housings for cameras and camera straps	February 17, 2004	December 20, 2005

The GOPRO registration is valid and subsisting and is conclusive evidence of GoPro's exclusive right to use the mark in commerce in connection with the goods specified therein. Registration No. 3,032,989 is also incontestable. There is no issue as to priority as the GOPRO mark was filed and registered prior to the Application filing date of January 16, 2013. *See*

Opposer's Notice of Reliance ("23 TTABVUE"), Ex. A; *cf.* Application No. 85825238.

GoPro is in the business of designing, manufacturing, marketing, and selling high resolution wearable cameras and accessories, including wearable mounts, such as head straps, helmet mounts, chest harnesses and wrist straps, used by a wide range of consumers, sports enthusiasts and others. Since at least as early as September 2004, GoPro has used the GOPRO mark in connection with the goods listed in Reg. No. 3,032,989. The GOPRO Marks are extensively used and easily recognized throughout the United States. Further, GoPro has achieved uncommon national recognition, winning—among other awards—an Emmy, for its technological contribution to film making. Because of GoPro's extensive marketing, promotion, advertising, and sales activity, the GOPRO mark is now famous, and identified as a designator of GoPro's goods—goods which are sold in over 25,000 stores, and in more than 100 countries. GoPro's goods have achieved a world-class profile, and are now the stock-in-trade for adventure and extreme sports enthusiasts, as well as anyone who enjoys chronicling their lives and adventures.

As one prominent and especially probative example, GoPro's GOPRO camera was used to capture Felix Baumgartner's free fall from Red Bull's stratospheric capsule in October 2012. By virtue of their common ethos, the energy drink company, Red Bull, is a natural partner for GoPro to team-up with to capture significant feats and sporting moments. In fact, GoPro and Red Bull recently entered a multi-year cross-promotional partnership that includes the exclusive affiliation of GoPro cameras with Red Bull events and media productions. This partnership aims to strengthen the global affiliation of the GoPro and Red Bull brands, and expand the distribution channels for both companies' branded media content.

B. Applicant's Application to Register the Mark GOPRO G (and design)

On January 16, 2013, Applicant applied to register the GOPRO G (and design) mark for various drinks and juices, including energy drinks in International Class 32. *See* Application No. 85825238. On November 13, 2013, the GOPRO G (and design) mark was published for opposition through a Notice of Publication. GoPro filed its notice of opposition to Applicant's Application on April 2, 2014. *See* 1 TTABVUE. On October 27, 2014, Applicant filed his answer. *See* 11 TTABVUE.

On February 3, 2016, GoPro served Applicant with its First Set of Requests for Admission ("RFA"). *See* 23 TTABVUE 21-33, Ex. B. Applicant did not respond to the RFAs with a written answer or objection (or otherwise) within 30 days. Accordingly, under Federal Rule of Civil Procedure 36(a)(3) and TBMP § 407.03(a), Applicant is deemed to have admitted each of the requested admissions in the RFA.

Applicant's refusal to answer the RFAs is part of his pattern of refusing to participate in the opposition proceedings against Application No. 85825238. For example, Applicant likewise failed to respond to GoPro's First Set of Interrogatories and First Set of Requests for Production of Documents served on February 3, 2016. And in the related opposition against Application No. 85825238, the Board entered a Default Judgment against Applicant and refused registration of Application No. 85825238 in International Class 25. *See* Opposition 91215504 (TTABVUE Nos. 23 – 26).

SUMMARY OF THE RECORD AND ISSUES TO BE DECIDED

Under Trademark Rule 2.122 and 37 C.F.R. §2.122, the record includes the pleadings in this proceeding and the file history of Application No. 85825238. Additionally, GoPro offered, through Notices of Reliance, the following further evidence:

- A true and correct copy of GoPro's registration of the GOPRO mark, U.S. Trademark Registration No. 3,032,989. 23 TTABVUE 6-14, Ex. A.
- Applicant's admissions represented by Applicant's failure to respond to the true and correct copy of GoPro's First Request for Applicant's Admission. *See* 23 TTABVUE 21-33, Ex. B.
- Third-Party registrations that cover the sale of both cameras and energy drinks. *See* 23 TTABVUE 42 - 212, Exs. D – R.

Based on this record, the issues to be decided in this opposition are the following:

1. Whether the Board should sustain GoPro's opposition to Application No. 85825238 for the GOPRO G (and design) mark under Section 2(d) of the Lanham Act on the grounds that the registration of Application No. 85825238 is likely to cause consumer confusion with GoPro's GOPRO marks.
2. Whether the Board should sustain GoPro's opposition to Application No. 85825238 for the GOPRO G (and design) mark under Section 43(c) of the Lanham Act on the grounds that the registration of Application No. 85825238 will dilute the distinctiveness of the famous GOPRO mark to GoPro's detriment.
3. Whether the Board should sustain GoPro's opposition to Application No. 85825238 for the GOPRO G (and design) mark under Section 2(a) of the Lanham Act on the grounds that the registration of Application No. 85825238 is deceptive and creates a false sense of a connection.

ARGUMENT

A. GoPro's Registration No. 3032989 Establishes Its Priority and Standing.

Here, there is no question that the famous GOPRO mark has priority over the confusingly similar GOPRO G (and design) mark. Applicant admitted that GoPro's GOPRO mark was both registered and famous before his own first use or application. *See* 23 TTABVUE 25 (Admissions Nos. 1 – 7). Additionally, GoPro's first-use dates, filing dates, and registration dates all precede Applicant's filing date and any claimed or conceivable first-use date. *See id.* Applicant has not and cannot produce any evidence to the contrary. GoPro's GOPRO mark has priority over Applicant's GOPRO G (and design) mark.

Under the Lanham Act, "[a]ny person who believes that he would be damaged by the registration of a mark" may file an opposition. Lanham Act § 13(a), 15 U.S.C. § 1063(a). This threshold standing requirement is satisfied when an owner of a prior registration believes that an applied for mark is confusingly similar to their own. *See e.g., 7-Eleven, Inc. v. Lawrence Wechsler*, 83 USPQ 2d 1715 at *3 (TTAB 2007). GoPro's prior registration thus confers it standing to oppose Applicant's application to register a confusingly similar mark.

B. Registration of Application No. 85825238 for the GOPRO G (and design) Mark Is Likely to Cause Consumer Confusion with Opposer's GOPRO Marks.

This Board's determination under Section 2(d) is based on an analysis of all of the relevant, probative evidence in the record related to a likelihood of confusion. *See In re E. I. du Pont de Nemours & Co.*, 177 USPQ 563 (CCPA 1973); *see also Palm Bay Imports, Inc.*, 73 USPQ 2d 1689. The thirteen-factor test from *In re E. I. Du Pont de Nemours* provides the framework for this analysis, but the Board need not consider each Du Pont factor. *See Han Beauty Inc. v. Alberto-Culver Co.*, 57 USPQ 2d 1557, 1559 (Fed. Cir. 2001). Rather, the Board

is required only to consider those factors that are most relevant in the case at hand. *Id.* The most relevant factors here are: (1) the similarity between the GOPRO and GOPRO G (and design) marks; (2) the fame of the GOPRO mark; (3) the similarity of the goods; (4) the overlap between GoPro and Applicant's trade channels; (5) the conditions under which, and buyers to whom, the sales are made; and (6) Applicant's intent in selecting the mark.

As provided below, there is no doubt that confusion as to source, sponsorship or affiliation is a highly likely result of Applicant's use of a virtually identical GOPRO G (and design) mark, with related goods, sold to unsophisticated buyers, in the same channel of trade as GoPro's use of its GOPRO Marks.

1. The Marks Are Virtually Identical in Appearance, Sound, and Commercial Impression.

The similarity between the GOPRO and GOPRO G (and design) marks is not in dispute. Applicant admits the marks are "virtually identical," both visually and auditorily. 23 TTABVue 28; 31 (Admissions Nos. 34 – 39; 60). The only difference is the addition of the letter G. But this single-letter distinction is barely a difference at all, since the first five letters of the marks are identical and have a correspondingly identical sound. Moreover, the Federal Circuit has consistently held that a likelihood of confusion exists when the marks are partially identical, even if an additional term is appended. *See e.g., In re Mighty Leaf Tea*, 601 F.3d 1342, 1348 (Fed. Cir. 2010); *see also China Healthways Inst., Inc. v. Wang*, 491 F.3d 1337, 1341 (Fed.Cir.2007) (CHI and CHI PLUS is likely to cause confusion despite differences in the marks designs); *In re West Point–Pepperell, Inc.*, 468 F.2d 200, 201 (CCPA 1972) (WEST POINT PEPPERELL likely to cause confusion with WEST POINT for similar goods).

For example, in *China Healthways Inst., Inc. v. Wang* the Federal Circuit addresses the

similarity of the marks CHI and CHI PLUS. 491 F.3d at 1341. The Court held that the identical portions of the marks were sufficient to cause confusion, despite the presence of the additional element—*i.e.* the PLUS—and a distinguishable design. *Id.*

The similarities in the marks in the present case are even more striking. The Applicant has merely added a single letter “G” to the end of the GOPRO mark—not an entire new word as in the CHI PLUS case. Moreover, GoPro’s mark is registered as a standard character mark, which covers all renditions of the mark. *See Pom Wonderful LLC v. Hubbard*, 775 F.3d 1118, 1125 (9th Cir. 2014) (plaintiff’s word mark was registered as a standard character mark, thus the registration covers the word in any design presentation). Thus, any design features added to the presentation of GOPRO G (and design) cannot negate the overwhelming similarity to the GOPRO mark. Accordingly, this factor weighs strongly in GoPro’s favor and the likelihood of confusion.

2. GoPro’s Mark Is Famous.

The Applicant admits that the GOPRO mark is famous, and has been famous at all relevant times. 23 TTABVUE 25 (Admissions Nos. 1 – 6). Applicant also admitted that he selected the GOPRO G (and design) mark because it is similar to the famous GOPRO mark. *Id.* at 28 (Admissions Nos. 31 – 39). This admitted fame of the GOPRO mark supports a likelihood of confusion.

“As a mark’s fame increases, the [Lanham] Act’s tolerance for similarities in competing marks falls.” *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 22 USPQ 2d 1453, 1456 (Fed.Cir.1992). This is because “famous marks are more likely to be remembered and associated in the public mind than a weaker mark,” and consumers are less likely to perceive any differences from a famous mark. *Bose Corp. v. QSC Audio Products, Inc.*, 63 USPQ 2d 1303,

1307 (Fed. Cir. 2002).

Moreover, when selecting a mark, applicants have a special duty to avoid similarities with famous marks. The Federal Circuit has admonished repeatedly:

There is no excuse for even approaching the well-known trademark of a competitor . . . and . . . all doubt as to whether confusion, mistake, or deception is likely . . . to be resolved against the newcomer, especially where the established mark is one which is famous.

Nina Ricci S.A.R.L. v. E.T.F. Enters. Inc., 12 USPQ 2d 1901, 1904 (Fed. Cir. 1989); *see also*, *Kenner Parker Toys Inc.*, 22 USPQ 2d at 1456 (“a strong mark . . . casts a long shadow which competitors must avoid”); *J & J Snack Foods Corp. v. McDonald’s Corp.*, 18 USPQ 2d 1889, 1892 (Fed. Cir. 1991) (“The newcomer has the clear opportunity, if not the obligation, to avoid confusion with well-known marks of others.”). As Applicant is a newcomer to the field, his admitted intent to copy a famous mark further requires resolving any question of confusion against him. *Nina Ricci S.A.R.L.*, 12 USPQ 2d at 1904.

3. The Application Covers Goods that Are Related to Goods Offered by GoPro.

Applicant also admits that Applicant’s GOPRO G (and design) goods are related to GoPro’s GOPRO goods. 23 TTABVUE 26 (Admissions Nos. 13 – 15); *In re Melville Corp.*, 18 USPQ 2d 1386 (TTAB 1991) (explaining that this factor favors rejection of an application where the goods or services at issue “are related in some manner,” or if “the circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances that could give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each parties’ goods or services.”); *Bose Corp.*, 63 USPQ 2d at 1306 (explaining that when the mark is famous, a likelihood of confusion can exist even when

the relatedness of the newcomer's goods is attenuated).

Here, Applicant seeks to register its GOPRO G (and design) mark for the sale of energy drinks. *See* Application No. 85825238. In the minds of consumers, energy drinks are related to action cameras—GoPro's core product. In addition to Applicant's admissions, this relationship is evidenced by the multiple third-party registrations GoPro has submitted, which cover both cameras and energy drinks. *See* 23 TTABVUE, Ex. C (listing third-party registrations covering both camera and energy drinks); *see also id.* at 26 (Admissions Nos. 13 – 15) (admitting relatedness of the goods at issue); *see also In re Mucky Duck Mustard Co.*, 6 USPQ 2d 1467, 1470 n.6 (TTAB), *aff'd per curiam*, 864 F.2d 149 (Fed. Cir. 1988) (explaining that third-party registrations may suggest that different goods are of a type that commonly emanate from a single source).

This factor favors GoPro.

4. GoPro and Applicant's Trade Channels.

Applicant admits that he currently uses, and intends to continue using the same trade channels as GoPro to market and sell his goods. *See* 23 TTABVUE 26-27 (Admissions Nos. 16 – 28). Specifically, Applicant admits to selling and marketing his goods in the same retail establishments and internet venues as GoPro, and that this overlap is likely to cause confusion. *Id.*; *see also American Hygienic Labs Inc. v. Tiffany & Co.*, 12 USPQ 2d 1979, 1983 (TTAB 1989) (explaining that similar trade channels can increase a likelihood of confusion).

Additionally, neither the GOPRO G (and design) application, nor the GOPRO registration, have any limits as to channels of trade. *See* Application No. 85825238; *see also* 23 TTABVUE, Exhibit A. “[I]n the absence of specific limitations in the application and registration,” the Board presumes the listed goods to travel in all “normal and usual channels of

trade and methods of distribution.” *CBS Inc. v. Morrow*, 218 USPQ 198, 199 (Fed. Cir. 1983); *Hewlett-Packard Co. v. Packard Press Inc.*, 62 USPQ 2d 1001, 1005 (Fed. Cir. 2002) (“absent restrictions in the application and registration, goods and services are presumed to travel in the same channels of trade to the same class of purchasers.”). Thus, the GOPRO G (and design) goods and GoPro’s GOPRO goods must be presumed to travel in the same channels of trade for their related goods.

This factor, as well, strongly favors GoPro.

5. Applicant’s Customer Are Impulse Buyers.

Applicant admits that he sells his goods to unsophisticated buyers that overlap with that of GoPro. *See* 23 TTABVUE 25-26 (Admissions Nos. 7 – 12). When the goods at issue are purchased by unsophisticated on inattentive buyers, the likelihood of confusion among customers is increased. *See Palm Bay Imports, Inc.*, 396 F.3d at 1376. Accordingly, this factor also weighs in favor of GoPro.

6. Applicant Selected His Confusingly Similar Mark with an Intent to Confuse.

Applicant admits that he selected the GOPRO G (and design) mark, in part, because it is likely to be confused with GoPro’s GOPRO mark. *See* 23 TTABVUE 28 (Admissions Nos. 32 – 39). This intent to confuse, supports a likelihood of confusion. *See Edom Laboratories, Inc. v. Glenn Lichter*, 102 USPQ 2d 1546, 1555-56 (TTAB 2012) (applicant’s intent to confuse buyers into thinking applicant’s product was that of the opposer supported finding of likelihood of confusion).

This final factor too, weighs in GoPro’s favor.

In sum, the *du Pont* factors support and compel the conclusion that Applicant’s GOPRO G (and design) mark is likely to create confusion with GoPro’s GOPRO mark. On the basis of

this confusion, the Board should enter judgment under Section 2(d) of the Lanham Act and refuse Application No. 85825238.

C. Registration of Application No. 85825238 for the GOPRO G (and design) Mark Is Likely to Dilute Opposer's Famous GOPRO Mark.

To establish a claim for dilution, an opposer must prove that its mark is and was famous before the applicant filed its application, and that some blurring or tarnishing of the famous mark is likely to occur if the registration is granted. *See* § 43(c) of the Lanham Act; 15 U.S.C. § 1125(c); *see also 7-Eleven, Inc.*, 83 USPQ 2d at 1730 (explaining the elements of a dilution claim in the opposition context).

Applicant admits that Opposer's mark is and was famous at all relevant times, including before he filed his application. 23 TTABVUE 25 (Admissions Nos. 1 – 6). Applicant admits that his GOPRO G (and design) mark is “virtually identical” to GoPro's GOPRO mark. 23 TTABVUE 31 (Admission No. 60). Applicant admits that he is seeking to register the GOPRO G (and design) mark with related goods and through the same channels of trade as GoPro. 23 TTABVUE 26-29 (Admissions Nos. 16 – 28; 40 – 49). And, Applicant admits “that the GOPRO G (and design) mark is likely to impair the distinctiveness of [Opposer's] GOPRO [mark].” 23 TTABVUE 33 (Admission No. 81). These admissions support the judgment that Applicant's registration of the GOPRO G (and design) mark will blur or tarnish GoPro's famous GOPRO mark.

The Board should also sustain GoPro's opposition on the basis of dilution under Section 43(c).

D. Registration of Application No. 85825238 for the GOPRO G (and design) Mark Will Create a False Suggestion of a Connection with GoPro.

To establish a claim of false suggestion of a connection under Section 2(a), an opposer

must prove that (1) applicant's mark points uniquely to opposer as an entity; (2) that purchasers would assume that goods sold under applicant's mark are connected with opposer; and (3) priority. *See Miller Brewing Co. v. Anheuser-Busch Inc.*, 27 USPQ 2d 1711, 1712-13 (TTAB 1993).

Applicant admits that: (1) his GOPRO G (and design) mark is "virtually identical" to GoPro's GOPRO mark; (2) that consumers are likely to confuse the two marks; (3) that GoPro is not in a business relationship with applicant; (4) that GoPro's mark is famous; (5) that the GOPRO G (and design) mark is likely to confuse consumers as to the affiliation of the goods used under it; and (6) that GoPro's famous mark has priority. *See* 23 TTABVUE 28; 33; 25 (Admissions Nos. 34 – 39; 78 – 81; 1 – 6). The Board should thus deny applicant's registration on the additional ground of this false suggestion of a connection under Section 2(a).

CONCLUSION

Applicant's admissions and the evidence submitted by GoPro establish that Applicant knowingly adopted a mark confusingly similar to the famous GOPRO mark. Applicant furthers this confusion by using its mark with related goods and through the same channels of trade as GoPro. There is no doubt that confusion between these marks is likely. Even if such doubt existed, "any doubts about likelihood of confusion must be resolved against the applicant as the newcomer." *Century 21 Real Estate Corp. v. Century Life of Am.*, 23 USPQ 2d 1698, 1701 (Fed. Cir. 1992). "This is especially true when the prior mark is famous." *Id.*

These same admissions and evidence submitted by GoPro establish that Applicant's mark is also likely dilute GoPro's famous GOPRO mark, and that the GOPRO G (and design) mark will create a false suggestion of connection with GoPro. The application must, therefore, be refused registration.

GoPro respectfully requests that the Board sustain its opposition and enter a judgment refusing Application No. 85825238.

Dated: October 10, 2016

/Eric Ball/

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PROOF OF SERVICE BY MAIL

I declare that:

I am employed in the County of Santa Clara, California. I am over the age of eighteen years and not a party to the within cause; my business address is Silicon Valley Center, 801 California Street, Mountain View, CA 94041. On the date indicated below, I served the **OPPOSER GOPRO INC'S TRIAL BRIEF** on the interested parties in said case, by placing a true copy thereof enclosed in a sealed envelope with postage thereon fully prepaid, in the United States mail at Mountain View, California, addressed as follows:

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Australia

I declare under penalty of perjury that the foregoing is true and correct, and that this declaration was executed at Mountain View, California, this 10th day of October, 2016.

/Anita E. Ersoy/
Anita E. Ersoy